REMARKS

This is a full and timely response to the non-final Office Action mailed on October 3, 2005 (Paper No./Date 092805). Reconsideration and allowance of the Application and present claims are respectfully requested.

Response to Rejection under 35 U.S.C. §103

Claims 3-5, 7-12, 14-15, 17-19, 21, 23-27, 29-32, 35-38, and 40-58 have been rejected under §103(a) as allegedly obvious over U.S. Patent No. 6,832,385 to *Young, et al.* in view of U.S. Patent No. 6,481,011 to *Lemmons*.

A. Claim 41

Claim 41, as amended, recites:

> 41. A method that is implemented via a digital home communication terminal for managing television presentation recordings comprising:
>
> determining if a television presentation corresponding to a television presentation listing is scheduled to be recorded;
>
> assigning a first color to the television presentation listing if the television presentation is scheduled to be recorded, wherein the color can be selected from a selectable option by a user;
>
> determining whether the television presentation has a time scheduling conflict with another television presentation that is scheduled to be recorded;
>
> ***assigning a second color responsive to determining that the television presentation has a time scheduling conflict with the another television presentation that is scheduled to be recorded***; and
>
> ***presenting the television presentation listing as part of an interactive program guide (IPG) having the second color as a background color for the television presentation listing***, wherein the IPG includes a main program display area that contains the television presentation listing that is assigned the second color and information corresponding to the availability of the television presentation listing for viewing during at least one time period.

(Emphasis Added)

1. The combination of *Young* and *Lemmons* fails to disclose, teach, or suggest "assigning a second color responsive to determining that the television presentation has a time scheduling conflict with the another television presentation that is scheduled to be recorded; and presenting the television presentation listing as part of an interactive program guide (IPG) having the

second color as a background color for the television presentation listing," as recited in claim 41

The Office Action admits as follows:

> "[*Young*] fails to [disclose] assigning a color to the television presentation listing of the television presenation is scheduled to be recorded wherein the color can be selected from a selectable option by a user and determining the color based on whether the television presentation has a time scheduling conflict with another television presentation that is scheduled to be recorded."
>
> (Page 3 of the Office Action)

In combining *Young* with *Lemmons*, the Office Action stated as follows:

> "*Lemmons* discloses a program guide system wherein the user selects the desired color of the backgroung of the various options of the EPG. As seen in Figures 6 and 10 the user has the option to choose color of various aspects of the EPG including a specific color for an actor to a color based on the recording of a show as further described in Column 9 lines 43+. By allowing the user to select the color options of the cell provides a more personal look to the programming guide which will make it easier to use for the user. Therefore, it would have been obvious to one on ordinary skill in the art at the time of the invention to use the electronic program guide, as disclosed by *Young et al*, and further incorporate an EPG that allows the user to select the desired color of the cells, as disclosed by *Lemmons*."
>
> (Pages 3-4 of the Office Action)

In fact, *Lemmons* discloses as follows:

> "The user may select particular program characteristics (of the many available) to serve as preference attributes and assign a color for each preference attribute. The preference attribute and its respective colors are associated as display criteria for use by the program guide. More particularly, the colors may be displayed in the program guide to provide visual emphasis to programming that meets the preferred criteria, and to allow the user to quickly and easily recognize such programming. Programming which does not fall within the preferred criteria is also displayed, although without particular color coding.

> The subject invention provides several ways the user can define programming preferences with greater specificity than simply by channel or broad genre. The user may select particular ones of the program characteristics as preference attributes. For example, preference attributes may be the title of a serial program or the name of an actor. Likewise, a preference attribute may be a programming genre or category, or a topic of interest. Thus, a user may inform the program guide that the user likes a particular serial program, such as "60 Minutes," a particular actor, such as John Wayne, a particular programming category, such as soap operas. Conversely, a user may inform the program guide of programs, actors, or genres that the user dislikes. The preference attributes are selected from the program listings data, described above. For each of these preferences, the user may assign a color. After the selections have been made, the program guide may access program listings data and search for programming having the preferred preference attributes. When a program satisfies any of the above criteria, the program guide then displays the listing or cell associated with the television program in an associated color."
>
> (Column 5, lines 29-52 of *Lemmons*)

Applicants respectfully assert that nowhere does *Lemmons* disclose, teach, or suggest assigning a color to a television presentation listing that is scheduled to be recorded and has a time schedule conflict with another television presentation listing. Accordingly, Applicants respectfully submit that *Lemmons* fails to disclose, teach, or suggest "assigning a second color responsive to determining that the television presentation has a time scheduling conflict with the another television presentation that is scheduled to be recorded; and presenting the television presentation listing as part of an interactive program guide (IPG) having the second color as a background color for the television presentation listing," as recited in claim 41.

Because *Young* and *Lemmons* fail to disclose, teach, or suggest the above-emphasized features of claim 41, Applicants respectfully submit that the combination of *Young* and *Lemmons* also fails to disclose, teach, or suggest each and every element of claim 41. Thus, a *prima facie* case of obviousness is not established based on *Young* and *Lemmons*. Consequently, for at least this reason, among others, Applicants respectfully request that claim 41 be allowed and the rejection be withdrawn.

2. The Office Action fails to cite a proper suggestion or motivation for combining *Young* with *Lemmons* in rejecting claim 41.

Applicants respectfully submit that the Office Action has failed to cite a proper suggestion or motivation for combining *Young* with *Lemmons* in rejecting claim 41. This alleged motivation is clearly improper in view of well-established Federal Circuit precedent. It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

> "The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. *See In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *Gambro Lundia AB*, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, No 98-1553 (Fed. Cir. January 27, 2000).

Although the suggestion to combine references may flow from the nature of the problem, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed.Cir.1996), "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness," *Monarch Knitting Mach. Corp. v. Sulzer Morat Gmbh*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed.Cir.1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.' " *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed.Cir.1992) (quoting *Lindemann*, 730 F.2d at 1462, 221 USPQ at 488).

The motivation alleged by the Office Action (*i.e.*, "to use the electronic program guide, as disclosed by *Young, et al*, and further incorporate an EPG that allows the user to select the desired color of the cells, as disclosed by *Lemmons*") is clearly insufficient, in view of the foregoing Federal Circuit precedent. Indeed, the motivation must be present in the prior art itself, and must be such that it would lead an artisan to make the particular combination without the benefit of hindsight. Here, the alleged motivation clearly does not satisfy these requirements. For at least these additional reasons, the rejections of claim 41 under 35 U.S.C. § 103(a) should be withdrawn.

B. Claims 23 and 50

Claim 23 recites:

23. A system for managing television presentation recordings comprising:

determination logic for determining if a television presentation corresponding to a television presentation listing is scheduled to be recorded;

assignment logic for assigning a color to the television presentation listing in response to the determination logic determining that the television presentation is scheduled to be recorded and has a time scheduling conflict with another television presentation that is scheduled to be recorded, wherein the color can be selected from a selectable option by a user; and

presentation logic for presenting the television presentation listing having the color that indicates that the television presentation has the time scheduling conflict and is scheduled to be recorded, the television presentation listing being presented as part of a requested interactive program guide (IPG), wherein the IPG includes a main program display area that contains the television presentation listing that is assigned the color and information corresponding to the availability of the television presentation listing for viewing during at least one time period.

(Emphasis Added)

Claim 50, as amended, recites:

50. A method for managing television presentation recordings comprising:

presenting selectable options for selecting and assigning colors to a television presentation listing that is scheduled to be recorded;

determining if the television presentation corresponding to a television presentation listing is scheduled to be recorded;

assigning a color to the television presentation listing if the television presentation is scheduled to be recorded; and

presenting the television presentation listing as part of an interactive program guide (IPG) having the color as a background color for the television presentation listing, wherein the IPG includes a main program display area that contains the television presentation listing that is assigned the color and information corresponding to the availability of the television presentation listing for viewing during at least one time period.

(Emphasis Added)

Applicants respectfully submit that the combination of *Young* and *Lemmons* also fails to disclose, teach, or suggest the above-emphasized elements of claims 23 and 50. Thus, a *prima facie* case of obviousness is not established based on *Young* and *Lemmons*. Consequently, for at least this reason, among others, Applicants respectfully request that claim 41 be allowed and the rejection be withdrawn.

C. Claims 53 and 54

Claim 54, as amended, recites:

> 53. The method of claim 50, wherein presenting the selectable option comprises presenting an IPG color selection screen for selecting colors for designating characteristics of the television presentation listing, the designating characteristics including scheduled recording, recording time conflict, storage capacity conflict and time and capacity conflict.
>
> 54. The method of claim 53, wherein presenting the selectable options comprises presenting an IPG color priority selection screen for selecting priorities for the colors selected to be assigned to the designating characteristics of the television presentation listing.

Applicants respectfully assert that nowhere does *Lemmons* disclose, teach, or suggest the feature of "presenting an IPG color selection screen for selecting colors for designating characteristics of the television presentation listing, the designating characteristics including scheduled recording, recording time conflict, storage capacity conflict and time and capacity conflict," (Emphasis Added) as recited in claim 53, and the feature of "presenting an IPG color priority selection screen for selecting priorities for the colors selected to be assigned to the designating characteristics of the television presentation listing," as recited in claim 54. Thus, a *prima facie* case of obviousness is not established based on *Young* and *Lemmons*. Consequently, for at least this reason, among others, Applicants respectfully request that claims 53 and 54 be allowed and the rejection be withdrawn.

D. Dependent Claims

Because independent claims 23, 41, and 50 are allowable over the cited art of record, dependent claims 3-5, 7-12, 14-15, 17-19, 21, 23-27, 29-32, 35-38, 40-52 and 55-58 are allowable as a matter of law for at least the reason that dependent claims 3-5, 7-12, 14-15, 17-19, 21, 23-27, 29-32, 35-38, 40-52 and 55-58 contain all features and elements of their respective

independent base claims. *See, e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to dependent claims 3-5, 7-12, 14-15, 17-19, 21, 23-27, 29-32, 35-38, 40-52 and 55-58 should be withdrawn for at least this reason, among others.

CONCLUSION

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

Applicants respectfully maintain that the currently pending claims are in condition for allowance. Should the Examiner have any comments or suggestions that would place the subject patent application in better condition for allowance, she is respectfully requested to telephone the undersigned attorney at (770) 933-9500.

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